

Application Serial No.: 10/681,086
Amendment Dated: June 30, 2009
Response to Office Action Dated: March 30, 2009

REMARKS

INTERVIEW SUMMARY

On March 21 and March 24, 2009, telephonic Examiner's Interviews were conducted between Jihong Zang, Applicants' attorney, and Examiner Chih Min Kam. During the Interview, amendment to the claims to place the application in condition for allowance and submission of a terminal disclaimer were discussed.

CLAIM OBJECTIONS

Claim 32 was objected to because of the use of the term "[a] production microorganism." (Paper No. 20090325 at 2). The Examiner further suggested the use of "[a] riboflavin production microorganism." (*Id.*)

In accordance with the Examiner's suggestion, claim 32 has been amended to recite "[a] riboflavin production microorganism made by the process of claim 23." Support for this amendment may be found in the specification at, for example, page 13, lines 12-16; page 18, lines 5-9; and Examples 1-3 (pages 19-28).

It is submitted that no new matter has been introduced by the foregoing amendment. Approval and entry of the amendment is respectfully solicited.

TERMINAL DISCLAIMER

Claim 32 was rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claim 9 of U.S. Patent 6,656,721 (the "721 patent"). (Paper No. 20090325 at 2-3). In making the rejection, the Examiner asserted that both claim 32 of the instant application and claim 9 of the

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'721 patent "recite a riboflavin production microorganism" and that "claim 32 of the instant application is directed to a genus of riboflavin production microorganisms, while claim 9 of the ['721] patent is directed to a species of riboflavin production microorganism." (*Id.* at 3). The Examiner concluded that "claim 32 in [the] present application and claim 9 [of the '721] patent are obvious variation[s] of a riboflavin production microorganism." (*Id.*)

We note that this rejection is inconsistent with restriction practice because claims 23-32 of the present application were the subject of a restriction requirement in the parent case (USSN 09/633,927, the "927 application"), being designated as Group II. Group III (claims 33-40) were elected for prosecution in the '927 application, which issued as the '721 patent. Group II claims were presented for prosecution in the present case, which was filed before the issuance of the '721 application. Thus, the Examiner's rejection appears to fly in the face of the statute. (See, e.g., 35 U.S.C. § 121. "A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.")

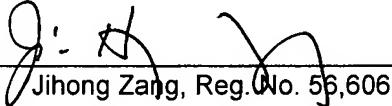
During the interviews, the Examiner asserted that a requirement further restricting claim 32 will be made unless the applicant disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of the '721 patent. While the

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propriety of the restriction requirement is disagreed with, to avoid further delays and additional unjustified costs to further prosecution, a terminal disclaimer is being filed concurrently herewith.

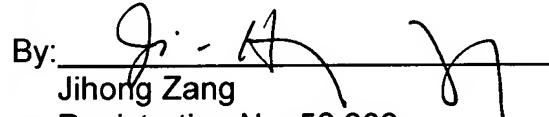
In view of the foregoing, it respectfully is submitted that all claims should be found allowable and that the application is in condition for allowance. If the Examiner has any questions regarding this paper, please contact the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 30, 2009.



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